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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,008	07/09/2001	Yoshiyuki Shino	35.C15536	4382

5514 7590 04/24/2003

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER	
DICUS, TAMRA	

ART UNIT	PAPER NUMBER
1774	9

DATE MAILED: 04/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/900,008	Applicant(s) SHINO ET AL.	
	Examin r Tamra L. Dicus	Art Unit 1774	

-- The MAILING DATE of this communication appears on th cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 February 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *9-19* is/are pending in the application.

4a) Of the above claim(s) *9-13* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *14-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Response to Amendment

The Examiner acknowledges cancellation of claims 1-8.

Claim Objections

1. The use of term "JIS P 8177". Applicant is advised to delete such language from claims 15 and 19, as it is a foreign standard.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 17 and 18 is rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,254,525 to Nakajima et al.

4. Nakajima teaches a thermal transfer image-recording material for an ID card. The card is layered in the following order: a support, an adhesive (equivalent barrier/base material functionality), image-receiving layer with an ink sheet/layer over to form the image (ink receiving). The IC memory is on the support. See col. 1, lines 35-45, col. 6, lines 1-23, col. 7, lines 1-15, col. 10, lines 15-60.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 14-16, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,254,525 to Nakajima et al. in view of USPN 4,841,134 to Hida et al.

Nakajima teaches a thermal transfer image-recording material for an ID card. The card is layered in the following order: a support, an adhesive, a cushion or barrier layer, image-receiving layer with an ink sheet/layer over to form the image (ink receiving), optional peeling layer of silicone resin and ink sheet. At col. 15, lines 10-30, the barrier layer is taught by Nakajima to be between 1 and 50 microns, meeting Applicant's claimed range from 0.5 to 20 microns of claim 16. The barrier layer is used to prevent dye diffusion, the same as Applicant claims. Nakajima also teaches at col. 17 a subbing layer which may serve as a barrier material.

Nakajima does not teach a base material *per se*. Hida teaches an IC card comprising in the following order: an oversheet 2b, a reinforcing sheet (equivalent to base material), adhesive (6), and IC (4). The reinforcing sheet may be a mesh-like sheet is a knitted or woven resinous material used to promote adhesion and serve to increase the thickness of the card. The reinforcing sheet may be 10-500 micrometers thick. See col. 3, line 43- col. 4, line 30. Hence it would have been obvious to one of ordinary skill in the art to modify the image-recording material with a base material of a reinforcing mesh-like material for the purpose of promoting adhesion and serve to increase the thickness of the card as taught by Hida. Regarding the air permeability property of claim 15 and 19, Nakajima is silent to teaching a barrier layer having an air permeability property. However, such property is optimizable as it depends upon the fibrous spacing of the filaments in a nonwoven sheet. Hence it would have been obvious to one of ordinary skill in the art to modify the recording material of Nakajima to include a layer having

air permeability properties since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272. Air permeability is effected by filament spacing in a nonwoven sheet.

Response to Arguments

A valid restriction requirement only needs to show groups are distinct and independent, which is true in this case. A process group is distinct from a product group, as set forth in the previous Office Action date Nov. 1, 2002. The restriction requirement is made FINAL.

7. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USPN 6,098,889 to Ogawa et al. teaches an optical recording medium with an IC module. USPN 6,514,367 to Leighton teaches a plastic smart card and hot lamination process. USPN 6,173,898 to Mande teaches a memory card of the contactless type being laminated. USPN 5,471,044 to Hotta et al. teaches an information recording card having a coating liquid for printing. USPN 5,589,307 to Takeuchi teaches a printing plate having electric members covered with a barrier of water-repellant resin and silicone resin.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is (703) 305-3809. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone numbers for the

organization where this application or proceeding is assigned are (703) 746-8329 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Tamra L. Dicus
Examiner
Art Unit 1774

April 21, 2003

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700